

REMARKS

The Office Action dated July 19, 2006 has been received and considered. In this response, the specification and drawings have been amended to correct objections made by the Examiner in the Office Action. Specifically, the specification and Figs. 1 and 3 have been amended to correct spelling and minor labeling inconsistencies as noted in the Office Action. In addition, claims 3-4, 6, 8-14, 16-18, and 20-21 have been amended to eliminate multiple dependency and correct minor objections made by the Examiner. No new matter has been added. Entry of the amendments to the specification, drawings, and claims is therefore respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. THE INFORMATION DISCLOSURE STATEMENT

An Information Disclosure Statement and accompanying PTO-1449 form was filed on May 13, 2005. Initially, Applicants thank the Examiner for considering the references identified in the Information Disclosure Statement.

II. THE OBJECTION TO THE SPECIFICATION

On page 4 of the Office Action, the Abstract was objected to "because it contains the legal phrase 'said apparatus'". Although Applicants respectfully disagree with the Examiner's objection, the Abstract has been amended, without prejudice, for the purposes of expediting prosecution. Therefore, in view of the foregoing, it is respectfully requested that the aforementioned objection to the Abstract be withdrawn.

On page 4 of the Office Action, the use of the trademark "Velcro" was objected to because the Examiner stated that "[i]t should be capitalized where it appears and be accompanied by the generic terminology." Applicants respectfully submit that in every use of the word, "Velcro," it has been capitalized and has been accompanied by "®" to indicate registration. As a result, it is respectfully requested that the aforementioned objection to the use of Velcro be withdrawn.

On page 5 of the Office Action, the disclosure of the specification was objected to because "reference 32 is defined as both the belt surface and a flange" (Specification,

page 8, lines 23 and 26) and “substantially plane” should have been “substantially planar” (Specification, page 8, line 36). In this response to the Office’s objections, Applicants submit that “belt surface 32” has been amended to “belt surface 31” (in the specification and the drawings) and “substantially plane” has been amended to “substantially planar” to correct for these minor informalities. In view of the foregoing, it is respectfully requested that the aforementioned objection to the disclosure be withdrawn.

III. THE OBJECTION TO THE CLAIMS 8, 9, and 12

On page 5 of the Office Action, claims 8, 9, and 12 were objected to for “lack of antecedent basis.” Applicants respectfully disagree with the Examiner’s objections since antecedent basis was previously established through multiple dependency of the claims. However, for the purpose of expediting prosecution, Applicants respectfully submit that claims 8, 9, and 12 have been amended, without prejudice, to clarify the alleged antecedent basis objection by eliminating multiple dependency. In view of the foregoing, it is respectfully requested that the aforementioned objection to claims 8, 9, and 12 be withdrawn.

VIII. THE ANTICIPATION REJECTION OF CLAIMS 1-5, 8-12, 14-16, and 22-23

On page 5 of the Office Action, claims 1-5, 8-12, 14-16, and 22-23 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by WO86/07017 to Bergman. This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. In re Sun, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. Id. “In addition, the prior art reference must be enabling.” Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). Such

possession is effected only if one of ordinary skill in the art could have combined the disclosure in the prior art reference with his/her own knowledge to make the claimed invention. Id.

As stated in MPEP § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 1 recites a "tool guiding apparatus for guiding a tool along a path on a surface to be processed, said apparatus comprising...automatic tool actuation means *adapted to advance the tool along the path*" (emphasis added). Bergman does not disclose this limitation.

Regarding claim 1, the Examiner alleges that Berman discloses a "tool guiding apparatus for guiding a tool along a path on a surface to be processed, said apparatus comprising...automatic tool actuation means *adapted to advance the tool along the path*." The Examiner alleges that the "anchorage device 5" of Bergman is the same as the "tool" as recited in the claims. However, Applicants respectfully disagree. First, the anchorage device 5 of Bergman is "fixable to the screen" in order to "positionally fix" the cutting wire 3 in relation to the screen 1 or chassis. *See* Bergman, Abstract; page 5, lines 20-22. By contrast, the tool of present invention is guided "along the path" on a surface. In other words, the tool is not fixed to the screen; rather, the tool moves and "advances" along the path, as expressly recited in claim 1. Second, the tool according to exemplary embodimentsof the present invention is a cutting tool that is pulled by along the path to perform the cutting function. See also Fig. 3. By contrast, the anchorage device 5 of Bergman does not perform any other function other than positionally fixing the wire. In fact, it is the wire that performs the "cutting" function, not the anchorage device 5. As a result, Bergman fails to disclose each and every element of the claimed invention. Accordingly, for at least the reasons discussed above, is it respectfully submitted that Bergman does not anticipate claim 1 and is therefore allowable over Bergman.

Regarding claims 2-5, 8-12, 14-16, and 22-23, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as

discussed above, claims 2-5, 8-12, 14-16, and 22-23 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination. For example, claim 6 recites that "the tool is a knife with a cutting edge." Bergman does not disclose a tool that is a knife with a cutting edge. Rather Bergman's tool is an "anchorage" device that "positionally fixes" the cutting wire to the shield.

Regarding claims 22-23, these claims recite subject matter related to claim 1. Thus, the arguments set forth above with respect to claim 1 are equally applicable to claims 22-23. Accordingly, it is respectfully submitted that claims 22-23 are allowable over Bergman for the same reasons as set forth above with respect to claim 1.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1-5, 8-12, 14-16, and 22-23 be withdrawn.

IV. THE OBVIOUSNESS REJECTION OF CLAIMS 6-7, 13, AND 17-21

On page 8 of the Office Action, claims 6-7 and 17 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bergman in view of U.S. Patent No. 4,481,059 to Steck.

On page 9 of the Office Action, claim 13 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bergman in view of U.S. Patent No. 3,886,926 to Hall.

On page 9 of the Office Action, claims 18-19 and 21 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bergman in view of U.S. Patent No. 4,215,475 to Morford et al. ("Morford").

On page 10 of the Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bergman (by the Examiner taking "Official Notice").

Each of these rejections are hereby respectfully traversed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some

objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. Id. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. Id. However, the motivation cannot come from the applicant's invention itself. In re Oetiker, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. Id.

Regarding claims 6-7, 13, and 17-21, Steck, Hall, and Morford fail to cure the deficiencies of Bergman. For example, Steck discloses a tool for manipulating a wire for cutting. *See* Steck, Abstract. Hall discloses a wire saw. *See* Hall, Title. Morford discloses an oscillating cut-out tool. *See* Morford, Abstract. None of these references disclose a "tool guiding apparatus for guiding a tool along a path on a surface to be processed, said apparatus comprising...automatic tool actuation means *adapted to advance the tool along the path;*" as expressly recited in the claims. Accordingly, it is respectfully submitted that claims 6-7, 13, and 17-21 are not obvious over Bergman in view of Steck, Hall, or Morford, and should be allowable for the reasons discussed above.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejections of claims 6-7, 13, and 17-21 be withdrawn.

V. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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Dated: November 20, 2006

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